

REMARKS

Claims 23 to 30 are added, and therefore claims 8, 9, 11 to 13, 15 to 17, 19 to 21, and 23 to 30 are pending.

It is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Claims 8, 9, 11 to 13, 15 to 17, and 19 to 21 were rejected under 35 U.S.C. §103(a) as unpatentable over Salecker (GB 2 317 660).

To reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Also, as clearly indicated by the Supreme Court in *KSR*, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *See KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, at 1396. Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Still further, to reject a claim as obvious under 35 U.S.C. § 103, the prior art must disclose or suggest each claim feature and it should also provide a motivation or suggestion for combining the features in the manner contemplated by the claim. (See *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); *In re Bond*, 910 F.2d 831, 834 (Fed. Cir. 1990)). Thus, the “problem confronted by the inventor must be considered in determining whether it would have been obvious to

combine the references in order to solve the problem”, Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 679 (Fed. Cir. 1998).

While the rejections may not be agreed with, to facilitate matters, claim 8 has been rewritten to provide the features of checking by a control unit, in the event of a starting command, as to whether the vehicle is stationary, and if the vehicle is not stationary, authorizing a starting of the engine without a brake intervention. Support for the features may be found in the Substitute Specification (e.g., at page 3, lines 28 to 31; and page 4, lines 3 to 9).

The Final Office Action admits (at page 2) that “Salecker et al. does not disclose ‘making a check as to whether the vehicle is stationary.’” As to Salecker, it does not disclose or suggest the feature of a control unit checking whether the vehicle is stationary, as provided for in the context of claim 8, as presented. In this regard, the Substitute Specification at page 3, lines 8 to 18 describes a control unit 30 for checking that does not use a human operator. Therefore, Salecker does not disclose or suggest the feature checking by a control unit, in the event of a starting command, as to whether the vehicle is stationary, as provided for in the context of claim 8, as presented.

Further, there is no motivation or suggestion to modify Salecker to include the feature of checking as to whether the vehicle is stationary, since Salecker repeatedly and consistently requires that the vehicle be stationary by applying a vehicle brake prior to granting a starter release. (See Salecker et al., page 10, lines 1 to 2; see also Salecker et al., page 3, lines 7 to 10, and 31 to 33; page 4, lines 7 to 11; page 5, lines 24 to 28; page 7, line 34 to page 8, line 3; and page 8, lines 18 to 21.) Accordingly, because the vehicle of Salecker is required to be stationary prior to starting, *there is no need for a control unit to check whether the vehicle is stationary*. Therefore, there is no motivation or suggestion to modify Salecker to include the feature of checking by a control unit, in the event of a starting command, as to whether the vehicle is stationary, as provided for in the context of claim 8, as presented.

In addition, Salecker does not disclose nor suggest the feature of authorizing a starting of the engine without a brake intervention. As explained above, Salecker specifically requires that the vehicle is stationary by applying vehicle brakes prior to starting. Accordingly, Salecker does not disclose authorizing a starting without a brake intervention if the vehicle is not stationary, as provided for in the context of the presently claimed subject matter. Thus, Salecker does not disclose nor suggest the feature of authorizing a starting of

the engine without a brake intervention if the vehicle is not stationery, as provided for in the context of claim 8, as presented.

Further, the Final Office Action at pages 3 to 4 inexplicably refers to a “push start” method to cure this deficiency of Salecker, but Salecker does not even mention any such “push start” method. Moreover, there is no motivation or suggestion to modify Salecker to include a “push start” method because, as explained above, Salecker requires that the vehicle be stationary prior to starting. Therefore, there is no motivation or suggestion to modify Salecker to include the feature of authorizing a starting of the engine without a brake intervention if the vehicle is not stationary, as provided for in the context of claim 8, as presented.

Accordingly, it is respectfully submitted that claim 8, as presented, is allowable, as are its dependent claims 9, 11 to 13, 15 to 17, and 19 to 21. Withdrawal of the rejections is therefore respectfully requested.

Claims 8 and 9 were rejected under 35 U.S.C. §103(a) as unpatentable over Balz (WO 99/50112). (U.S. Patent No. 6,702,405 is a U.S. National Stage entry of International Patent Application Publication WO 99/50112.)

The Final Office Action admits (at page 4) that “Balz et al. does not distinctly disclose ‘making a check as to whether the vehicle is stationary.’” As to Balz, it does not disclose the feature of checking by a control unit whether the vehicle is stationary, as provided for in the context of claim 8, as presented. In this regard, the Substitute Specification at page 3, lines 8 to 18 describes a control unit 30 for checking that does not use a human operator. Therefore, Balz does not disclose nor suggest the feature of checking by a control unit, in the event of a starting command, whether the vehicle is stationary, as provided for in the context of claim 8, as presented.

Further, there is no motivation or suggestion to modify Balz to include the feature of checking whether the vehicle is stationary. In this regard, Balz repeatedly and consistently specifically requires that the vehicle be stationary (either parked or by application of a parking brake) prior to starting the vehicle. (See Balz, column 1, line 62 to column 2, line 14.) Accordingly, because the vehicle of Balz is required to be stationary prior to starting, there is no need to check whether the vehicle is stationary. Therefore, there is no motivation or suggestion to modify Balz to include the feature of checking by a control unit, in the event

of a starting command, whether the vehicle is stationary, as provided for in the context of claim 8, as presented.

In addition, Balz does not disclose nor suggest the feature of authorizing a starting of the engine without a brake intervention if the vehicle is not stationary. As explained above, Balz specifically requires that the vehicle be stationary by either being parked or by applying a parking brake prior to starting. Accordingly, Balz does not disclose the feature of authorizing a starting without a brake intervention if the vehicle is not stationary, and it therefore does not disclose nor suggest the feature of authorizing a starting of the engine without a brake intervention if the vehicle is not stationary, as provided for in the context of claim 8, as presented.

Further, contrary to the Final Office Action's assertions as to a "push start" method, Balz does not even mention a "push start" method. Moreover, there is no motivation or suggestion to modify Balz to include a "push start" method because, as explained above, Balz requires that the vehicle be stationary prior to starting. Therefore, there is no motivation or suggestion to modify Balz to include the feature of authorizing a starting of the engine without a brake intervention if the vehicle is not stationary, as provided for in the context of claim 8, as presented.

As further regards all of the obviousness rejections, any Official Notice is respectfully traversed to the extent that it is maintained and it is requested that the Examiner provide specific evidence to establish those assertions and/or contentions that may be supported by the Official Notices under 37 C.F.R. § 1.104(d)(2) or otherwise. In particular, it is respectfully requested that the Examiner provide an affidavit and/or that the Examiner provide published information concerning these assertions. This is because the § 103 rejections are apparently being based on assertions that draw on facts within the personal knowledge of the Examiner, since no support was provided for these otherwise conclusory and unsupported assertions. (See also MPEP § 2144.03).

Accordingly, it is respectfully submitted that claim 8, as presented, is allowable, as is its dependent claim 9. Withdrawal of the rejections is therefore respectfully requested.

New claims 23 to 30 do not add any new matter and are supported by the present application, including the specification. Claim 23 includes features like those of claim 8 and

it is therefore allowable for essentially the same reasons, since the applied references do not disclose, or even suggest, the features of a control unit configured to check, in the event of a starting command, whether the vehicle is stationary, and if the vehicle is not stationary, the control unit is configured to authorize starting of the engine without a brake intervention, as in claim 23. Claims 24 to 30 depend from claim 23, and they are therefore allowable for the same reasons.

Accordingly, claims 8, 9, 11 to 13, 15 to 17, 19 to 21, and 23 to 30 are allowable.

CONCLUSION

It is therefore respectfully submitted that all of the presently pending claims are allowable and it is respectfully requested that the rejections (and any objections) be withdrawn. Since all issues raised by the Examiner have been addressed, an early and favorable action on the merits is respectfully requested.

Date: _____

12/18/2009

Respectfully submitted,

KENYON & KENYON LLP

By: _____

Gerard A. Messina
Reg. No. 35,952

One Broadway
New York, New York 10004
(212) 425-5288

CUSTOMER NO. 26646